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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,451	12/14/2001	Charles S. Taylor	GUID003CON3	1695
7590 07/13/2004			EXAMINER	
ALAN W. CANNON LAW OFFICE OF ALAN W. CANNON 834 SOUTH WOLFE ROAD SUNNYVALE, CA 94086			NASSER, ROBERT L	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/020,451	Applicant(s) TAYLOR, CHARLES S.	
	Examiner Robert L. Nasser	Art Unit 3736	<i>cc</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15,26,29 and 33-47 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 36 and 40 is/are allowed.
- 6) ☒ Claim(s) 15,26,29,33,34,37-39,41-45 and 47 is/are rejected.
- 7) ☒ Claim(s) 35 and 46 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 26, 29, 33, 37-39, 41-43, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiguchi et al. Nishiguchi shows a suction paddle having a plurality of or an array suction ports the is sized for picking up 2 and 3 inch wafers, which is therefore sized to grasp the heart. The cross sectional relationships are not shown. However, the examiner notes that applicant has not stated that the relative sizes of the elements solves a stated problem and has not stated that the relative sizes are for a specific reason. Therefore, in the absence of criticality, the relative sizing of the elements would have been mere matter of design choice. With respect to claims 37-39, the off center relationship is not shown. However, the examiner notes that applicant has not stated that the relative sizes of the elements solves a stated problem and has not stated that the relative sizes are for a specific reason. Therefore, in the absence of criticality, the relative position of the elements would have been mere matter of design choice. With respect to claim 42, the semicircular shaped device of Nishiguchi et al can be thought of as two pieces joined in the middle.

Claims 15, 26, 29, 33, 34, 37-44, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al. Vierra et al shows a device having two members each with an array of suction ports 73 in the members,

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where the members are capable of contacting a surface of a small heart or individually contacting the heart. The members are contoured to a surface of the heart. The cross sectional relationships are not shown. However, the examiner notes that applicant has not stated that the relative sizes of the elements solves a stated problem and has not stated that the relative sizes are for a specific reason. Therefore, in the absence of criticality, the relative sizing of the elements would have been mere matter of design choice. With respect to claims 37-40, the off center relationship is not shown. However, the examiner notes that applicant has not stated that the relative sizes of the elements solves a stated problem and has not stated that the relative sizes are for a specific reason. Therefore, in the absence of criticality, the relative position of the elements would have been mere matter of design choice. With respect to claim 42, the semicircular shaped device of Nishiguchi et al can be thought of as two pieces joined in the middle.

The examiner notes that the rejection based on Vierra might be overcome if applicant were to recite that the suction ports were in the contoured surface, as the suction ports of Vierra are in the side surface and the bottom surface is the suction surface.

Claims 36 and 40 are allowable.

Claims 35, 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Claims 35 and 46 44 define over the art in that none of the art shows a suction paddle having a surface contoured to the hart, where the suction ports open into the contoured surface.

Applicant's arguments filed 4/9/2004 have been fully considered but they are not persuasive.

Applicant has argued that devices like that of Nishiguchi are not surgical devices. The examiner notes that the term "surgical device" is merely an intended use recitation and is not sufficient to define over identical structure used in a different manner. See *In re Schreiber* 44 USPQ2d 1429 (Fed. Cir. 1997)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (703) 308-3251. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert L. Nasser
Primary Examiner
Art Unit 3736

RLN
July 8, 2004

ROBERT L. NASSER
PRIMARY EXAMINER